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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/508,617 03/14/00 IDEI

K 000225

EXAMINER

023850 IM52/0705  
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FERGUSON, I  
ART UNIT PAPER NUMBER

1774  
DATE MAILED:

4  
07/05/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trad marks**

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/508,617	IDEI ET AL.
	Examiner	Art Unit
	Lawrence Ferguson	1774

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 14 March 2000.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-4 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-4 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved.

12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

15) Notice of References Cited (PTO-892)

16) Notice of Draftsperson's Patent Drawing Review (PTO-948)

17) Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.

18) Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_

19) Notice of Informal Patent Application (PTO-152)

20) Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections – 35 USC § 103(a)*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Idei et al. (*U.S. 5,958,579*).

3. Applicant claims a paper for ink jet and electrophotographic recording.

4. Idei discloses an ink jet recording sheet employing a drying device comprising a support and a cationic resin attached to the support where the cationic resin is attached preferably in an amount of from 0.2 to 2.0 g/m<sup>2</sup> (column 2, lines 61-67) as a dry attaching amount (column 14, lines 24-25). Idei discloses a rosin sizing agent (column 6, line 7). Idei discloses the support of the ink jet recording sheet may contain waste paper pulp (column 6, lines 31-40). Idei does not disclose an amount of cation equivalent; however, Idei uses the same cationic resin material as applicant in the same amounts that applicant uses. Therefore the amount of cation equivalence would be expected to be the same as instantly claimed. In claim 2, the claim language, “measured by colloidal titration method” is product by process terminology. “Even though product by process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its

method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 227 USPQ 964, 966. Idei does not disclose a surface resistivity. However the same materials are being used to make the paper. It would have been obvious to one of ordinary skill in the art to include the claimed resistivities because the same compounds, i.e. rosin and cationic resin, are being used in the same manner. The claimed resistivities would be expected, absent any evidence to the contrary.

***Claim Rejections – 35 USC § 103(a)***

5. Claim 1 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koji et al. (EP 0745488A1).
6. Applicant claims a paper for ink jet and electrophotographic recording.
7. Koji discloses an ink jet recording sheet that may be used as a recording sheet for the electrographic recording system (page 5, lines 56-57). Koji discloses a support having a dry attaching amount of the cationic resin ranging from  $0.2\text{g/m}^2$  to  $2.0\text{g/m}^2$  (page 7, lines 1-27). Koji does not disclose a surface resistivity. The support of Koji includes a sizing agent made of rosin (page 4, line 16). Koji uses a cationic resin such as acrylamide – diallylamine (page 2, line 23). It would have been to one of ordinary skill in the art to make the claimed invention including the claimed surface resistivity because the reference uses the same cationic resin in the same

amounts as applicant claims to make a paper in the same manner which applicant claims. The surface resistivity would be expected to be the same, absent any evidence to the contrary.

***Conclusion***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence Ferguson whose telephone number is (703) 305-9978. The examiner can normally be reached on Monday through Friday 8:30 AM – 4:30PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on (703) 308-0449. Please allow the examiner twenty-four hours to return your call.

The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-5408 for regular communications and (703) 305-3599 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-2351.

*JDF*

Lawrence D. Ferguson  
Examiner  
June 29, 2001

**CYNTHIA H. KELLY  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1700**

*Cynthia H. Kelly*